

**Remarks**

Applicant has amended game kit claims 21, 23, 28, 30-32 and 40-41, game claims 25 and 27, and method of game playing claims 34-39. Applicant has also withdrawn method of game play claim 43 in favor of newly presented method of game play claim 44. In brief summary, the amendments presented here are designed to eliminate limitations in the claims that are directed to the effect of the game play upon the game player (e.g., stimulation of the player's semantic memory), and instead present claim limitations directed to the physical manifestation of the game design. So, using claim 21 as an example, rather than defining the first set of cards as "predictably requiring retrieval of a first type of information from primarily a first human memory system," applicant now focuses the claim limitations on the characteristics of the cards themselves, now defining the first set of cards as those which include tasks requiring a verbal response containing objective, not personally unique information. This same approach has been applied throughout the claims to include limitations directed to the content of the card sets or instructions, rather than their effect on the players.

There are at least two types of human memory systems that are the object of the game play, and in the case of some claims a third memory system is brought into the game. These three memory systems are the semantic memory, the episodic memory and short term memory. In the present amendment, applicant has replaced all references to the process of retrieving information from a player's particular memory system. Instead, the claims now include limitations to the content of the cards or instructions. In the case of the semantic memory, the claims have been amended to require that the cards or instructions require a verbal response containing objective, not personally unique information. Support for these amendments can be found, e.g., in Paragraphs [0038] and [0047] of applicant's Patent Publication US 2005/0093239 A1 (" '239 publication".) In the case of stimulation of the episodic memory system, applicant has amended the claims to recite that the cards or instructions require a verbal response that contains a personal story including subjective impressions and personal feelings. Support for this language can be found in the '239 publication at Paragraphs [0039] and [0048]. In the case of the claims that previously included reference to a third memory system, the short-term memory system, applicant has again presented amendments here that are focused on the content of the cards or instructions, rather than the effect of the card or instruction on the game player. In this instance, the cards or instructions

call for verbal responses that include random words, random numbers, or random sounds that have no commonly known association and no personal significance to the game players. This language is supported by the as-filed specification at Paragraphs [0040], [0055] and [0103] of the '239 publication.

**A. The Present Amendments Overcome the Rejection for Inoperativeness Under 35 USC Section 101**

At page 2 of the Office Action, the Examiner repeats a rejection of the claims under 35 USC Section 101, on the grounds that the invention claimed in the then-pending claims 21-25, 27, 28, 30-32, 34 and 36-43 was inoperative. In sum, the Examiner took the view that as the invention was claimed, it was inoperative and therefore lacks utility. The Examiner found that the semantic memory and the episodic memory are different and used differently from person to person. Moreover, according to the Examiner, people are highly likely to use all aspects of their memory in formulating a response to a question or a problem. The Examiner therefore concluded that the claim limitations calling for the performance of a task that "predictably requires retrieval of information primarily from one of a plurality of human memory systems" were inoperative because performance was a matter of individuality and could not be controlled.

As noted above, applicant has amended the game kit (claims 21, 23, 28-32, and 40-41), game (claims 25 and 27) and method of game play claims (34-39 and 44) to remove the limitations that involve the retrieval of responses from certain systems in the game player's memory. Elimination of these limitations in all of the pending claims moots the Section 101 rejection.

Instead, applicant has presented limitations that focus on the type of task, without referencing the portion or portions of the brain's memory systems that might be stimulated by the task. In making these amendments, applicant is not acquiescing in the Examiner's position with respect to the distinctness of the various human memory systems. To the contrary, applicant continues to gather data that demonstrates that its theoretical understanding is correct. Nonetheless, applicant recognizes that the theoretical basis for the game play is not necessary to provide a useful game play, nor to the process of obtaining a patent. Therefore, the claim limitations now focus on the types of tasks presented on the game cards or instructions, rather than the effect of these tasks on the game player. As such, the inoperativeness rejection has been overcome.

**B. The Objections to Form Under Section 112 have Been Overcome**

The Examiner pointed out certain lacks of antecedent bases for claim limitations. Applicant submits that all of these formalities have been addressed in the claim amendments submitted herewith. As to those aspects of the claim rejections that are based upon lack of antecedent basis, applicant respectfully requests that these rejections to the claims now be removed.

The Examiner also objected to claim 39 for lack of written description under Section 112, as it applied to the limitations discussing that one game player could move the game marker of another game player. Applicant respectfully disagrees and directs the Examiner's attention to Paragraph [0078] of the '239 publication where it is stated that "others [may] move a Player's maker onto a Memory Switch [the spaces in between the first and second paths or intersections.]"

**C. The Combination of Prior Art Proposed by the Examiner Fails to Render the Claimed Invention Obvious in View of Henry and Alexander**

All of the pending claims have been rejected under Section 103 in view of Henry combined with Alexander. Applicant first responds that these references should not be combined because they are directed to vastly different ways of making game play interesting. Henry describes a game used to teach players who are already predisposed about many different aspects of the criminal justice system, such as, e.g., the constitutional bases for criminal procedure in the courts, or biographical information about key people in the history of law enforcement. The cards used to interrogate the players are all directed to questions about the criminal justice system.

Alexander approaches game play design from a very different direction and with a very different purpose. The design-guiding basis for game play in Alexander involves the eight "core" human competencies as recognized by educational development researchers (e.g., language, spatial, logical-mathematical, musical, etc.) Alexander designed his game to address as many of these core human competencies as possible in a single game so that it would be interesting to play across a market composed of players who each demonstrate proficiency in different core competencies across the full spectrum. If the game is designed to address multiple core competencies, it will not be popular with only a single population demonstrating proficiency in a

single competency. Rather, Alexander hoped that his game would be popular among multiple populations with differing proficiencies in the core human competencies. Alexander based his game design on this principle and implemented the design accordingly.

Henry and Alexander are not combinable for purposes of an obviousness analysis because they represent games with vastly different design foundations that are implemented differently in the two games. Recently, the U.S. Supreme Court has rejected the teaching suggestion motivation (“TSM”) test of the obviousness analysis previously endorsed by the Federal Circuit. Instead the Supreme Court has re-directed the focus to the predictability of the outcome when components known in the prior art are combined together. Applicant submits that in this area of endeavor, board game design, it is very difficult indeed to predict the outcome from combining components allegedly found in the prior art. Since the success of a game is measured by the response of the market place to the game concept and implementation, it is very difficult to predict how the public will react. Moreover, the differing goals and purposes between the individual prior art games greatly reduces the value of knowing these prior art features or components. Many or most of them may not be compatible with the particular goal or purpose of the next inventor. Since the concepts behind Henry and Alexander are vastly different, the implementations of these disparate concepts are not in any respect interchangeable. Therefore, the teachings of Henry and Alexander should not be combined.

Even if one assumes that the teachings of these disparate games could be combined, an assumption that applicant traverses, the combination does not teach what is claimed in the pending claims, as amended herein. As amended, many of the claims require cards or instruction of at least two types. Some of the claims require three types of cards or instructions. One type of instruction calls for providing a verbal response that contains objective, not personally unique information. This type of card or instruction would encompass questions such as one might encounter in playing a game such as Trivial Pursuit. The second type of card or instruction calls for providing a verbal response that contains a personal story from the life of the game player, including subjective impressions and personal feelings. In those claims requiring a third set, the cards in the third set involve random words, random sounds, random data, etc., having no commonly known association and no personal significance to the game players. The two board games cited by the Examiner (Henry and Alexander) do not involve cards of the second or third type. There is no teaching in either Henry or Alexander to ask the players to perform tasks that involve personal stories

including subjective impressions and personal feelings, nor tasks that involve random words, random sounds, random data, etc., having no commonly known association and no personal significance to the game players. Absent these teachings in the references, there is no basis for asserting that claims that expressly recite these limitations concerning the card sets are invalid as obvious over the combination of Henry and Alexander. In conclusion, the rejection based upon these references under Section 103 must be withdrawn.

### **Conclusion**

The various rejections relating to recitation of the invention in terms of effect on the players' memory systems have been overcome by the present amendment. The claims now recite an affirmative limitation concerning the content of the card sets or instructions. The previous references in the claims as to the mechanism by which the player retrieves and presents an answer have been deleted. Moreover, the prior art rejection based upon Henry and Alexander cannot stand because the references are not combinable, nor are the selection and implementation of known components predictable in the art under consideration. Nor does the art teach the features of the card sets calling for personal stories or random information. The claims, as amended, are allowable, and the applicant solicits a Notice of Allowance.

Respectfully submitted,  
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